IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

EX PARTE HYUNG-SIK CHOI et al.

Application for Patent

Filed February 17, 2000

Serial No. 09/507,093

FOR:
ADVERTISING METHOD USING SOFTWARE PRODUCTS

APPEAL BRIEF

CERTIFICATE OF MAILING
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Signature: _____
Jiawei Huang

I. REAL PARTY IN INTEREST

The real parties in interest are HYUNG-SIK CHOI, the inventor(s) named in the subject application.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences.

III. STATUS OF THE CLAIMS

A total of 12 claims were presented during prosecution of this application. Applicants appeal rejected claims 1-3 and 5.

IV. STATUS OF THE AMENDMENTS

Applicant filed a Preliminary Amendment together with a Request for Continued Examination (RCE) after a final rejection, which was entered and considered by the Examiner.

V. SUMMARY OF THE INVENTION

The present invention is directed to an advertising method using software products in which at least one advertisement is inserted so that the software products can be distributed for free or at a low cost. The advertising method comprises inserting an advertisement into a software program contained in a software product during the making of the software product; making the software program stop in operation when the inserted advertisement is displayed on a display screen; and resuming the software program only when the inserted advertisement displayed on the display screen is clicked on. The software program with the inserted advertisement is reproducible and operable without connecting to the Internet.

VI. ISSUES

Were claims 1-3 and 5 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over HORSTMANN (U.S. 6,285,985) in view of Petrecca et al. (U.S. 5,781,894)?

VII. GROUPING OF THE CLAIMS

Claims 1-3 and 5 stand or fall together.

VIII. ARGUMENTS

A. The related law

"In order to justify a combination of references such as is here suggested it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so." *Ex parte Walker*, 135 USPQ 195, 196 (PTO Bd. App. 1961).

"The prior art itself may suggest the desirability of the combination, or the motivation may come from other sources." *In re Clinton, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976).* "That suggestion must, however, be present regardless of how "minor" or "trivial" the differences are between the claimed invention and the prior art." *Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).* Moreover, the motivation must come from somewhere other than the applicant or patentee. *In re Fricth, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).*

Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d, 1596 (Fed. Cir. 1988).

B. Claims 1-3 and 5 were rejected under 35 U.S.C. § 103 as being unpatentable over HORSTMANN (U.S. 6,285,985) in view of Petrecca et al. (U.S. 5,781,894).

Applicant respectfully traverses the rejection. For reasons set forth below, claim 1 is patentable over the cited prior art.

Claim 1 recites:

An advertising method using software products in which at least one

advertisement is inserted so that the software products can be distributed for free or at a low cost, the advertising method comprising the steps of:

inserting at least one advertisement into at least one portion of a software program contained in a software product ***during the making of the software product;***

making the software program stop in operation during use of the software program when the inserted advertisement is displayed on a display screen; and

resuming the software program only when the inserted advertisement displayed on the display screen is clicked on;

wherein the software program with the inserted advertisement is reproducible and operable without connecting to the Internet.

Horstmann does not teach or suggest the above emphasized features of claim 1.

Horstmann teaches a mechanism allowing a software developer to present advertisements through a software program by attaching an advertisement module to the software program. The function of the advertisement module is to retrieve advertisements from a separate advertisement server and to display them to the user so that the advertisements are varied to retain the interest of the user. (See abstract and col. 2, lines 1-15) Clearly, Horstmann teaches to attach an advertisement module to a software program, instead of directly inserting an advertisement into the software program. In order to display an advertisement to the user, the advertisement module would have to retrieve the advertisement from an advertisement server through Internet. It is Horstmann's purpose that "[T]he advertisements are varied to retain the interest of the user". The advertisement module serves this stated purpose.

From above, it is clear that, in Horstmann, the advertisement is not inserted into the software program *during the making of the software product* as required by claim 1, instead, it is retrieved later from an advertisement sever through the Internet.

In the present invention as defined in claim 1, the advertisement is directly inserted into a software program during the making of the software product, and is activated and displayed on a screen when the software program is executed. The software product with the inserted advertisement is reproducible and operable without connecting to the Internet. No advertisement module is used in the present invention. Horstmann does not teach or suggest that the software program of Horstmann can be reproduced together with the advertisement provided through the advertisement sever. And the software product of Horstmann clearly cannot be operated without connecting to the Internet because the advertisement module has to retrieve the desired advertisement from a remote advertisement sever. Col. 3, lines 1-5, 57-61; Col. 4, lines 48-61; Col. 5, lines 5-13; Figs. 4 and 5. Attaching an advertisement

module to a software program and then retrieving an advertisement from a remote advertisement server is different from directly inserting an advertisement into the software program during the making thereof.

Claim 1 further recites steps of "making the software program stop in operation during use of the software program when a sponsored advertisement is displayed on a display screen; and resuming the software program only when the sponsored advertisement displayed on the screen is clicked on". Horstmann does not teach resuming the software program only when the sponsored advertisement displayed on the screen is clicked on. Indeed, Horstmann does not teach an advertisement inserting concept, rather he discloses an advertisement module which is attached to a software product to retrieve advertisements from a separate advertisement server. In other words, in Horstmann's method, the advertisements are controlled by the advertisement module, the advertisement window inserted or appearing in the software is not interlocked with the stopping and assuming operation of the software.

The Office Action asserted that "[W]hile Horstmann does not specifically state that the software program resumes only when the sponsored advertisement is clicked on. It would have been obvious to one having ordinary skill in the art to have allowed the program to resume by clicking on the advertisement since this would have been adopted for the intended use of allowing the user to regain control over the use of the application...". Applicant respectfully disagrees. The feature of "resuming the software program only when the sponsored advertisement displayed on the screen is clicked on" is intended to make the user view the displayed advertisement before continuing the software program. By clicking on the advertisement screen, the user would have to view the advertisement. The Examiner cites no reference to show such a feature. The conclusion of obviousness appears to have been achieved by hindsight.

The Office Action further cited Petrecca and stated: "[P]etrecca teaches an advertising method using software products in which at least one advertisement is inserted comprising: inserting at least one advertisement into at least one portion of the software program during the making of the software (col. 2, lines 40-60, col. 3, lines 20-35)" and "[I]t would have been obvious to one having ordinary skill in the art at the time of the invention to have the

software program with the inserted advertisement operable without connecting to the internet as in Petrecca in the system of Horstmann since this would have allowed sponsors to reach more customers by providing another software distribution channel (disk)".

Applicant respectfully submits that the proposed combination of Petrecca's software program having the inserted advertisements into the system of Horstmann is improper.

"In order to justify a combination of references such as is here suggested it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so." *Ex parte Walker*, 135 USPQ 195, 196 (PTO Bd. App. 1961).

"The prior art itself may suggest the desirability of the combination, or the motivation may come from other sources." *In re Clinton, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976).* "That suggestion must, however, be present regardless of how "minor" or "trivial" the differences are between the claimed invention and the prior art." *Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).* Moreover, the motivation must come from somewhere other than the applicant or patentee. *In re Fricth, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).*

There is no suggestion or motivation for the proposed combination. As discussed above, Horstmann attaches an ad module to a software program to retrieve advertisements from a separate advertisement server, so that the advertisements are varied to retain the interest of the user. There is no need and desirability to insert an advertisement into the software program of Horstmann during the making of the software program as does in Petrecca because the ad module can provide more choice of advertisements, there is no need for another source of advertisements.

The concept of inserting an advertisement into a software program during the making thereof would be against the intended purpose of Horstmann. Horstmann expressly teaches that "[T]he advertisements are varied to retain the interest of the user". Col. 2, lines 9-10. "The function of the ad module is to retrieve and display to the user of the program various advertisements." Col. 3, lines 1-4. Once an advertisement is inserted into a software program during the making thereof, it will stay with the software in a recording medium, and cannot be varied without repeating the making process, that would be against the above teachings of

Horstmann.

Further, even if Horstmann and Petrecca were combined to form a system, in which an advertisement is inserted in the software program during the making thereof (as in Petrecca) and an ad module is attached to the program (as in Horstmann), the inserted advertisement would behave differently from that of the present invention. Horstmann does not teach how to control such inserted advertisement with the ad module. While, in Petrecca,

the inserted advertisement is not intended to interrupt the operation of the software program even when it is displayed on a screen. Pettrecca specifically teaches that the advertisement is shown only during the period of "waiting time" in which the computer is not able to accept new input from the user. Abstract, lines 1-4, Col. 1, lines 15-16 and 64-67. Petrecca further teaches a method for estimating the length of the waiting period so that an advertisement can be chosen which fits into this waiting period. Clearly, in Petrecca, the software program is neither interrupted by the display of the advertisement nor resumed by clicking on the advertisement.

For at least the foregoing reasons, Applicants respectfully submit claim 1 patently defines over Horstmann and Petrecca. For at least the same reasons, dependent claims 2-3 and 5 also patently define over Horstmann and Petrecca. Withdrawal of the rejections is respectfully requested.

IX. CONCLUSION

As noted, none of the cited art, either alone or in combination, can be said to render obvious the appealed claims. Specifically, the proposed combination of Horstmann and Pettrecca is improper and, even if they were combined as proposed, the combination would still fail to teach "resuming the software program only when the sponsored advertisement displayed on the screen is clicked on".

Accordingly, applicant believes that the rejections under 35 U.S.C. § 103 are in error, and respectfully requests the Board of Patent Appeals and Interferences to reverse the Examiner's rejections of the claims on appeal.

Respectfully Submitted,

Date: 11/24/2003

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APPENDIX A - CLAIMS ON APPEAL

1. (previously amended) An advertising method using software products in which at least one advertisement is inserted so that the software products can be distributed for free or at a low cost, the advertising method comprising the steps of:

inserting at least one advertisement into at least one portion of a software program contained in a software product during the making of the software product;

making the software program stop in operation during use of the software program when the inserted advertisement is displayed on a display screen; and

resuming the software program only when the inserted advertisement displayed on the display screen is clicked on;

wherein the software program with the inserted advertisement is reproducible and operable without connecting to the Internet.

2. (previously amended) An advertising method of claim 1, further comprising the step of downloading a software program, where an advertisement of an advertisement sponsor is included in at least a part thereof, from the Internet for free or at low cost.

3. (previously amended) An advertising method of claim 2, wherein when a software program including an advertisement in at least a part thereof is used, as the advertisement of an advertisement sponsor links to a web site such as the home page of an advertisement sponsor, the web site is easily accessed by clicking on the web site address.

Claim 4. (canceled).

5. (previously amended) An advertising method of claim 1, wherein a window through which at least one advertisement is displayed can exist as another open window on the display screen.

Claims 6-12. (canceled).

AF/3622 #

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UNITED STATE PATENT AND TRADEMARK OFFICE

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Application No. : 09/507,093
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Examiner : KEMPER, MELANIE A.
Art Unit : 3622

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November 24, 2003
(Date)

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TRANSMITTAL OF APPEAL BRIEF

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Transmitted herewith is an Appeal Brief in (9) pages, including (1) page of Appendix, in triplicate.

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